UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,654	10/10/2001	Daniel C. Burfoot		6187

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EXAMINER
BURGE, LONDRA C

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/973,654	BURFOOT, DANIEL C.
	Examiner	**Art Unit**	
	Londra C Burge	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/10/01*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) ☐ Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____ .	6) ☐ Other: _____ .

DETAILED ACTION

1. This action is responsive to communications: Original Application filed 10/10/2001.

2. Claims 1-8 are pending. Claims 1, 3 and 8 are independent claims.

Claim Rejections - 35 USC § 112

3. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. **Regarding claims 1, 3-5 and 7 the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).**

5. **Regarding claims 4 and 5, the phrase "or the like" and "similar" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).**

6. **Claims 1-8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1-8 provides for the use of "see Detailed Description section..." but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

7.   **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3 are rejected under 35 U.S.C. 101 because: the claimed invention is directed to non-statutory subject matter.

For your reference, below is a section from MPEP 2105:

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se **Data structures not claimed as embodied in computer-readable media are descriptive <u>material per se and are not statutory</u>** because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer- readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the

computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2 (b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

Claim Rejections - 35 USC § 102

8.   **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

> A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.   **Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Khan et al (herein after Khan) U.S. Patent No. 6,157,934 filed 10/15/1996.**

In regard to independent claim 1, Khan discloses *a) Maintains data representing spreadsheets in a persistence layer, such as a file system or database* (Khan Col 5 Lines 18-23); *b) Mows users to create, delete, and modify said spreadsheets, including especially the values and derivation formulae of the spreadsheet cells* (Khan Col 4 Lines 3-23); *c) Serves the derived values of said spreadsheet cells to client applications upon valid request* (Khan Col 4 Lines 3-23) *d) Runs calculations when necessary to derive the values of said spreadsheet cells* (Khan Col 4 Lines 3-23); *e) Performs various ancillary functions relating to the above tasks, such as maintaining user information encrypting data when desired, caching data to speed performance, enforcing an access control policy, and providing an interface for system administration and basic data access.* (Khan Col 4 Lines 14-33)

In regard to dependent claim 2, Khan discloses *while using data contained in another application as a source for spreadsheet data, by using a generic DSS front end to communicate with client programs and an adapter built specifically to connect the front end and the other application* (Khan Col 5 Lines 40-65)

In regard to dependent claim 3, Khan discloses *a) a format for DSS queries and DSS query responses, used for the communication of spreadsheet data wherein the client program constructs the query and the server replies with the query response* (Khan Abstract and Col 1 Lines 59-67 and Col 2 Lines 1-3); *b) a format for DSS commands and DSS command responses, allowing client programs to interact in various ways with the DSS server, such as creating or deleting spreadsheets, adding or editing cell values, adding or deleting users, and other operations*(Khan Col 4 Lines 3-23); *c) techniques to use to ensure the security of these communications.* (Khan Abstract and Col 1 Lines 59-67 and Col 2 Lines 1-60)

In regard to dependent claim 4, Khan discloses *a client application such as a desktop spreadsheet application using the protocol* (Khan Col 6 Lines 5-26)

In regard to dependent claim 5, Khan discloses *program to perform operations such as creating or deleting spreadsheets, adding, editing or removing cells in a spreadsheet, adding or deleting users of the DSS server, and various other operations, from a client application,.* (Khan Col 4 Lines 3-23)

In regard to dependent claim 6, Khan discloses *method for creating DSS cell reference formulae in spreadsheet applications to cell data served* (Khan Col 5 Lines 18-23) (Khan Col 4 Lines 3-23) (Khan Col 4 Lines 14-33)

In regard to dependent claim 7, Khan discloses *A method of integrating a third party application with a DSS server by modifying the application to report to the DSS server when certain events occur, such as sales, thereby allowing the DSS server to keep track of the reported information in a spreadsheet, and to share that information to DSS client applications* (Khan Col 6 Lines 12-63)

In regard to independent claim 8, Khan discloses *a method for preventing recalculation overload in the DSS server by keeping two distinct sets of spreadsheet data, one public and one private, where the former is updated from the latter at set intervals and otherwise does not change* (Khan Col 6 Lines 65-67 and Col 7 Lines 1-39)

Conclusion

10.   **The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.**

| Cahill et al. | U.S. Patent No. 6,779,151 B2 | issued | 8/17/2004 |
| Igra et al. | U.S. Patent No. 6,701,485 B1 | issued | 3/2/2004 |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Londra C Burge whose telephone number is (571) 272-4122. The examiner can normally be reached on 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

STEPHEN S. HONG
PRIMARY EXAMINER

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEPHEN S. HONG
PRIMARY EXAMINER

Londra C. Burge
12/1/2004